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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 09/878,864  | 06/11/2001  | Mark Nordlicht       | 20014380-0005                 | 2664             |
| 7278 7590 01/09/2007<br>DARBY & DARBY P.C.<br>P. O. BOX 5257<br>NEW YORK, NY 10150-5257 |             |                      | EXAMINER<br>AKINTOLA, OLABODE |                  |
|   |             |                      | ART UNIT                      | PAPER NUMBER     |
|   |             |                      | 3691                          |                  |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 01/09/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/878,864 | <b>Applicant(s)</b><br>NORDLICHT, MARK |  |
|                              | <b>Examiner</b><br>Olabode Akintola  | <b>Art Unit</b><br>3691                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-35 and 39-43 is/are pending in the application.  
     4a) Of the above claim(s) 26-31 and 41-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-35, 39 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's election with traverse of invention III in the reply filed on 10/26/2006 is acknowledged. Claims 1-25 and 36-38 have been cancelled. Claims 26, 29, 32 and 33 have been amended. Claims 39-43 are new.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Invention I: Claims 26-28 are drawn to a method of changing a transaction from a first market type to a second market type comprising transmitting account identifiers from a first client device and a second client device to a clearinghouse device, classified in class 705, subclass 36R.

Invention II: Claims 29-31 and 41-43 are drawn to a method of changing a transaction from a first market type to a second market type comprising transmitting first and second account identifiers from a first client device to a clearinghouse device, classified in class 705, subclass 36R

Invention III: Claims 32-35 and 39-40 are drawn to a method of changing a transaction from a first market type to a second market type comprising changing the transaction, at the first client device, from a first market type to the second market type, classified in class 705, subclass 36R

The inventions I-III are distinct, each from the other because of the following reasons:

Inventions I - III are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable.

These combinations are independent if it can be shown that (1) they are not disclosed as capable of use together, (2) they have different modes of operation, (3) they have different functions, or (4) they have different effects. (MPEP 806.04, MPEP 808.01). In the instant case, inventions I -III have different functions such transmitting account identifiers from a first client device and a second client device to a clearinghouse device, transmitting first and second account identifiers from a first client device to a clearinghouse device, changing the transaction, at the first client device. See MPEP § 806.05(d).

After a phone call on November 2, 2006, a provisional election with traverse was made by Mr. Louis DelJudice (Attorney for the Applicants) to prosecute claims 32- 35 and 39-40. Accordingly claims 26-31 and 41-43 are withdrawn from consideration as being directed to non-elected invention. Applicant is respectfully requested to cancel the withdrawn non-elected claims 26-31 and 41-43 in response to this office action.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 32-35 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al (USPN 5136501) ("Silverman") in view of Bernstein (USPN 6298335) ("Bernstein").

Re claims 32-35 and 39: Silverman teaches a method, comprising the steps of: at a first client device connected to a network, transmitting an offer to a second client device connected to the network, to conduct the transaction of the first market type (Abstract, Fig1); at the first client device, receiving an acceptance of the transaction from the second client device, where the acceptance from the second client device, where the acceptance contains a user identifier (col. 12, lines 41-43; col. 13, lines 41-60); sending a confirmation from the first client device to the second client device that indicates completion of the transaction (col. 13, lines 59-60);

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identifying that the user identifier has not met a predetermined condition (col. 3 line 52 thru col. 4, line 5); wherein the first market type is a clearing house market (col. 4, lines 64-65); wherein the first market type is a credit exchange market (col. 22, lines 1-10); and generating a user prompt by the first client device in response to the predetermined condition not being met (col. 3 line 52 thru col. 4, line 5).

Silverman does not explicitly teach changing the transaction, at the first client device from the first market type to a second market type; where the acceptance is of a second market type; and accepting the acceptance of the second market type. Bernstein teaches changing the transaction, at the first client device from the first market type to a second market type; where the acceptance is of a second market type; wherein the first market type is a clearing house exchange market; wherein the first market type is a credit exchange market; and accepting the acceptance of the second market type (Col. 3, lines 52-59; col. 4, lines 10-13). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Silverman to include this step as taught by Bernstein. One would have been motivated to do so in order to facilitate the transaction by accepting the proposed mode of payment as offered by the buyer.

Claims 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman in view of Bernstein as applied to claim 33 above, and further in view of Heilman, JR (USPAP 20010034689) ("Heilman").

Re claim 40: Silverman does not explicitly teach wherein the predetermined condition is the user identifier is absent from the list located on the first client device. Heilman teaches wherein the predetermined condition is the user identifier is absent from the list located on the first client

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device (sections 0015, 0072). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Silverman to include this step as taught by Heilman. One would have been motivated to do so in order to facilitate specific transactions with pre-approved counterparties meeting pre-defined parameters only.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wiseman (USPN 5168446) teaches a system for conducting and processing spot commodity transactions.

Shepherd (USPN 5970479) teaches a method and apparatus relating to the formulation and trading of risk management contracts.

Chenevich et al (USPAP 20020111886) teaches a payment management.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629.

The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



HANI M. KAZIMI  
PRIMARY EXAMINER